

Remarks:

Claims 1-4, 7-13, and 16-23 are pending. Applicant has amended the claims to distinctively claim the subject matter of the invention. By virtue of this amendment, claims 1, 10, 19, 21, and 22 are amended. No new matter is added as support for the amendments is found within the Specification and the drawings. It is submitted that the application, as amended, is in condition for allowance. Accordingly, reconsideration and reexamination are respectfully requested.

Applicant is not conceding that the subject matter recited in the amended or canceled claims during the prosecution of this matter is not patentable over the art cited by the Examiner. The amended or canceled claims are provided solely to facilitate expeditious prosecution of the allowable subject matter. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by the amended or canceled claims and additional claims in one or more continuing applications.

**§103 Rejection(s):**

Claims 1-4, 7-13, and 16-23 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,359,881 to Gerszberg et al. (hereafter “Gerszberg ‘881”) in view U.S. Patent No. 5,936,941 to Kondo et al. (hereafter “Kondo”) and further in view of U.S. Patent Publication No. 2001/0040621 to Gerszberg et al. (hereafter “Gerszberg ‘621”). This rejection is respectfully traversed.

It has been long held that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

In other words, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching,

suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ 2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ 2d 1941 (Fed. Cir. 1992).

Further, according to MPEP §2143,<sup>1</sup> to establish a prima facie case of obviousness, the Examiner must clearly articulate the reason(s) why the claimed subject matter would have been obvious at the time of invention. Exemplary rationales that may support a conclusion of obviousness include:

- (a) Combining prior art elements according to known methods to yield predictable results
- (b) Simple substitution of one known element for another to obtain predictable results
- (c) Use of known technique to improve similar devices (methods, or products) in the same way
- (d) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results
- (e) "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success
- (f) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art
- (g) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention

Gerszberg '881 is directed to architecture capable of utilizing the existing twisted pair interface between customer premises equipment and an associated serving local switching office. See Abstract. The architecture allows a videophone to display advertising when the videophone is not in active use. See column 11, lines 65-66.

Gerszberg '881 fails to teach or suggest all of the elements recited in claim 1, as amended. In particular, Gerszberg '881 fails to teach or suggest:

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<sup>1</sup> *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739-1741, 82 USPQ 2d 1385, 1395-97 (2007).

(1) determining a call status of each of the plurality of terminals based on call status information included in the call setup information exchanged between each of the plurality of terminals and the gateway system; and

(2) transmitting the stored information to each of the plurality of terminals that is in the on-hook status,

(3) wherein the stored information is not transmitted to each of the plurality of terminals that is in the off-hook status,

(4) wherein each of the plurality of terminals that is in the on-hook status displays the information transmitted from the information server on the display unit during the on-hook status,

(5) wherein each of the plurality of terminals that is in the off-hook status does not display the information transmitted from the information server on the display unit during the off-hook status.

In fact, Gerszberg '881 teaches away from claim 1, particularly elements (3) and (5). On page 4 of the Office Action, the Examiner alleges that Gerszberg '881 teaches the transmission of information to the terminal at any point in time. Claim 1, on the other hand, recites that information is not transmitted to the terminal during the off-hook status.

Since Gerszberg '881 teaches away from claim 1, it would be unreasonable to suggest that a person of ordinary skill in the art would be motivated to combine Gerszberg '881 with any other reference. Accordingly, Gerszberg '881 should be withdrawn for being an improper reference.

Kondo is directed to a communication system including a management terminal and a plurality of communication terminals connected to a communication network. The management terminal requests transmission of certain status information in a call setup message. See Abstract.

Kondo fails to cure the deficiencies of Gerszberg '881 as Kondo also fails to teach or suggest the elements (1) through (5) of claim 1. The Examiner contends that Kondo discloses element (1) of claim 1. Applicant respectfully disagrees.

Respectfully, §103 does not allow the Examiner to engage in a picking and choosing from the prior art only to the extent that it will support a holding of obviousness, while excluding parts of the prior art essential to the full appreciation of what the prior art suggests to one of ordinary skill in the art. *In re Wesslau*, 147 USPQ 391 (CCPA 1975).

As such, the status information disclosed in Kondo is patentably distinguishable from the call status recited in claim 1. That is, the status information in Kondo refers to information that is required by the management terminal to manage the communication terminals such as information related to failures or abnormal operations. See column 1, lines 44-46; column 2, lines 23-25. The call status information in claim 1, on the other hand, refers to an on-hook or off-hook status, which is related to whether a terminal is being used to make a call.

Gerszberg '621 is directed to an advertisement system for displaying advertisements on a video-enabled telephone when the telephone is linked with a non-video enabled telephone and/or when the videophone is put on hold. See Abstract.

Gerszberg '621 also fails to cure the deficiencies of Gerszberg '881 as Gerszberg '621 fails to teach or suggest elements (1) through (5) of claim 1. In fact, Gerszberg '621 directly teaches away from claim 1, particularly elements (3) and (5). On page 4 of the Office Action, the Examiner states that Gerszberg '621 teaches transmitting information to a terminal when the terminal is "not in use." Claim 1, on the other hand, recites that information is not transmitted to the terminal during the off-hook status (i.e., when the terminal is "not in use").

Since Gerszberg '621 teaches away from claim 1, it would be unreasonable to suggest that a person of ordinary skill in the art would be motivated to combine Gerszberg '621 with any other reference. Accordingly, Gerszberg '621 should be withdrawn for being an improper reference.

Further, while the suggestion to modify or combine references may come from the knowledge and common sense of a person of ordinary skill in the art, the fact that such knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge. *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998).

Here, the modification or combination proposed by the Examiner is not based on any clear and convincing evidence of a reason, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to combine the references. Rather, the reason, suggestion and motivation for the combination of references proposed by the Examiner simply is impermissible hindsight reconstruction given the benefit of Applicant's disclosure.

The Federal Circuit has consistently held that hindsight reconstruction does not constitute a prima facie case of obviousness under 35 U.S.C. §103. *In re Geiger*, 2 USPQ 2d 1276 (Fed Cir. 1987). Unfortunately, the Examiner rather than pointing to what the prior art discloses and teaches as to making the suggested modification relies on assumptions and statements without any support in the record. As such, the Examiner's statements regarding obviousness and motivation to modify are but shortcuts to a conclusion of obviousness devoid of the required analytical approach based on what is actually disclosed in the prior art.

Reliance on impermissible hindsight to avoid express limitations in the claims and setting forth unsupported hypothetical teachings to recreate the Applicant's claimed invention cannot establish a prima facie case of obviousness. Since obviousness may not be established by hindsight reconstruction, Applicant invites the Examiner to point out the alleged motivation to combine with specificity,<sup>2</sup> or alternatively provide a reference or affidavit in support thereof, pursuant to MPEP §2144.03.<sup>3</sup>

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<sup>2</sup> *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 USPQ 929, 933 (Fed. Cir. 1984).

<sup>3</sup> "The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner."

Since no reasonable justification is provided in the Office Action as to how such modification or combination is possible and obviousness may not be established based on hindsight and conjecture, it is respectfully requested that the §103 rejection be withdrawn.

For the above reasons, none of the cited references, either alone or in combination, teach or suggest all the elements recited in claim 1. Therefore, it is respectfully submitted that claim 1 is in condition for allowance. Claims 2-4 and 7-9 depend on claim 1 and should be in condition for allowance by virtue of their dependence on an allowable base claim. Claims 10 and 19 substantially incorporate the elements of claim 1; therefore, claim 10 and 19 and claims 12, 13, 16-18, and 21-23 depending from claims 10 and 19 should also be in condition for allowance.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, by way of telephone (213) 623 2221 or email [ffar-hadian@lhlaw.com](mailto:ffar-hadian@lhlaw.com), to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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